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APR 27 2006

U.S. PATENT & TRADEMARK OFFICE

UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

IN RE TED EUGENE WRIGHT, Petitioner,

v.

NOTICE OF APPEAL

UNITED STATES PATENT
AND TRADEMARK OFFICE,
BOARD OF PATENT APPEALS
AND INTERFERENCES

Respondent

TED EUGENE WRIGHT, hereby appeals the court for review of the Decision on Appeal of the UNITED STATES PATENT AND TRADEMARK OFFICE, BOARD OF PATENT APPEALS AND INTERFERENCES, entered on April 6, 2006.

The Petitioner received the decision of the UNITED STATES PATENT AND TRADEMARK OFFICE, BOARD OF PATENT APPEALS AND INTERFERENCES on April 12, 2006.

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The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte TED EUGENE WRIGHT

Appeal No. 2006-0003
Application 09/499,069

ON BRIEF

Before OWENS, WALTZ, and KRATZ, *Administrative Patent Judges*.

WALTZ, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on an appeal from the primary examiner's non-final rejection of claims 1 through 5, 7, and 11 through 21. The only other claim pending in this application is claim 6, which has been objected to by the examiner as depending on a rejected claim, but has been indicated as allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims (Answer, page 2, ¶(3), and page 8). Although the rejection appealed from was a non-final action (mailed June 4, 2004), we have jurisdiction since the claims have

been twice presented and rejected. See 35 U.S.C. § 134; *Ex parte Lemoine*, 46 USPQ2d 1420, 1422-23 (Bd. Pat. App. & Int. 1998).

According to appellant, the invention is directed to a single-sheet registration form and key packet intended for use in hotels, motels, and other such businesses in which customers are registered and provided with keys, where the clerk separates the registration form from the key packet along a line of perforations, and then assembles the key packet in two steps by folding along two lines of perforations, inserting one or more room keys into slots dye-cut into the key packet, and handing the assembled key packet to the customer (Brief, page 2).¹

Representative independent claims 1 and 11 are reproduced below:

1. A rectangular, single-sheet registration form and key packet comprising:
 - a registration form;
 - an unfolded key packet separated from the registration form by a line of perforations, the unfolded key packet including at most two lines of perforations that allow the unfolded key packet to be quickly and accurately folded into a complete key packet in two or fewer steps; and
 - one or more die-cut slots in the unfolded key packet which serve as a slot or slots to hold a number of keys in the complete key packet.
11. A single-sheet registration form and key packet comprising:
 - a single sheet dimensioned to feed through a commercially available computer printer, the single sheet including
 - a registration form,
 - an unfolded key packet separated [sic, separating] the registration form by a line of perforations, the unfolded key packet including at most two lines of

¹Unless otherwise noted, we refer to and cite from the Supplemental Brief on Appeal dated Oct. 7, 2004.

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perforations that allow the unfolded key packet to be quickly and accurately folded into a complete key packet in two or fewer steps, and
one or more die-cut slots in the unfolded key packet which serve as a slot or slots to hold a number of keys in the complete key packet.

The examiner has relied upon the following evidence of obviousness:

Thompson	3,655,119	Apr. 11, 1972
Crowell	4,592,573	Jun. 03, 1986
Skelton	4,850,611	Jul. 25, 1989

Claims 1-5 and 7 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Thompson in view of Skelton (Answer, page 3).

Claims 11-21 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Thompson in view of Skelton and Crowell (Answer, page 5).²

Based on the totality of the record, including due consideration of appellant's Brief dated March 11, 2004, the

²The examiner, in both the Answer and the non-final rejection mailed June 4, 2004, lists "claims 11-15" as subject to this ground of rejection. However, since appellant recognizes that the examiner intended to reject claims 11-21 and argues these claims as rejected (Brief, page 2, and page 4, first paragraph), we determine that appellant had adequate notice of this rejection. Furthermore, the examiner recognizes that claims 11-21 are rejected and sets forth a separate discussion of each claim (Answer, pages 2 and 5-8; Office action mailed June 4, 2004, pages 5-7). Therefore we consider this error harmless. For purposes of this appeal, we consider this rejection to include claims 11-21.

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Supplemental Brief dated Oct. 7, 2004, the Declarations and Exhibits, as well as the Answer and Office action dated June 4, 2004, we *affirm* both rejections on appeal essentially for the reasons set forth in the Answer and those reasons set forth below.

OPINION

The examiner finds that Thompson discloses a ticket envelope (10) comprising a registration form (26), an unfolded packet (combination of 22 and 24) separated from the registration form by a score line (40), where the unfolded packet includes at most two score lines (30 and 36) that allow the unfolded packet to be quickly and accurately folded into a complete packet in two or fewer steps, and a die-cut slot (42) in the unfolded packet which is capable of holding any number of items (Answer, page 3). Thus the examiner finds that Thompson discloses all the claim limitations except for the score lines being perforations as required by the claims on appeal (Answer, page 4). Therefore the examiner applies Skelton for its disclosure of a similar foldable envelope to that of Thompson, where the plurality of panels are separated from each other by a perforated, embossed or scored line, with Skelton further teaching that scores and perforations are equivalent structures known in the art for folding, with

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later possibilities of severing and separation (*id.*). From these findings, the examiner concludes that it would have been obvious to one of ordinary skill in this art at the time of appellant's invention to use alternate creasing methods in the ticket envelope of Thompson, i.e., to substitute lines of perforations, as taught by Skelton, for the score lines disclosed by Thompson (*id.*). We agree.

Implicit in our review of the examiner's obviousness analysis is that the claim must first have been correctly construed to define the scope and meaning of any contested limitations. See *Gechter v. Davidson*, 116 F.3d 1454, 1457, 1460 n.3, 43 USPQ2d 1030, 1032, 1035 n.3 (Fed. Cir. 1997). During examination proceedings, claims are given their broadest reasonable interpretation as the terms are ordinarily used, consistent with the specification. See *In re Morris*, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997); *In re Graves*, 69 F.3d 1147, 1152, 36 USPQ2d 1697, 1701 (Fed. Cir. 1995). With regard to the language used in claim 1 on appeal, we construe the claim as including at least³ a rectangular, single-sheet blank

³Note the use of the transitional term "comprising" which opens the claim to additional elements. See *Genentech Inc. v. Chiron Corp.*, 112 F.3d 495, 501, 42 USPQ2d 1608, 1613 (Fed. Cir. 1997).

where one portion of the blank is designated a "registration form," and that portion is separated from another portion of the blank (designated the "key packet") by a line of perforations. We further construe this claim as having this other portion of the blank including at most two lines of perforations, with the capability of being folded in two or fewer steps, and having one or more die-cut slots which are capable of serving as a slot to hold a number of keys. It is clear that the claim is directed to the "unfolded" product which merely has the capability of being folded to form a complete key packet and registration form, as disclosed and exemplified in appellant's Figure 2 (see claim 1 on appeal, line 3, and the specification, page 5, ll. 9-26).

Appellant argues that the ticket envelope disclosed by Thompson is "non-rectangular" while claim 1 on appeal requires a rectangular single-sheet registration form (Brief dated Mar. 11, 2004, pages 9-10; Reply Brief, unnumbered page 14). Appellant further argues that the unfolded form of Skelton is not rectangular (Brief, pages 6-7; Reply Brief, unnumbered page 14). These arguments are not persuasive. Merely changing the shape of a paper form does not render the claimed form patentable, absent some showing of criticality. See *In re Dailey*, 357 F.2d 669, 672-73, 149 USPQ 47, 50 (CCPA 1966). Appellant does not allege,

much less show, any criticality for the shape of the registration form.⁴ We note that independent claim 11 on appeal does not require any particular shape for the single-sheet registration form and key packet. Finally, we note that Skelton was only relied upon by the examiner to show the art-recognized equivalency of score lines and perforations, and thus was not relied upon to show a rectangular form.

Appellant argues that Thompson fails to teach, mention or suggest a rectangular, single-sheet entity of any kind, two components separable via perforations, and a key packet including at most two lines of perforations (Brief dated Mar. 11, 2004, page 12; Reply Brief, unnumbered page 16). Appellant also argues that Thompson does not disclose a key packet that would be "sufficiently stiff or properly dimensioned" for holding metallic keys or key cards (Reply Brief, unnumbered page 16).

Appellant's arguments are not persuasive. As admitted by the examiner, Thompson does not disclose or teach the use of perforations to fold the portions of the single-sheet form (Answer, page 4). However, the examiner has applied Skelton for its teaching of alternative or equivalent methods of creasing or

⁴To the contrary, appellant's specification teaches that the single-sheet registration form "may have any number of different shapes" (page 8, ll. 10-12).

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folding the portions of a single-sheet form, namely the equivalence of score lines and perforations (*id.*). See *In re Fout*, 675 F.2d 297, 301, 213 USPQ 532, 536 (CCPA 1982) ("Express suggestion to substitute one equivalent for another need not be present to render such substitution obvious"). Appellant has not addressed the combination of prior art references as a whole but simply improperly argues the merits of each reference individually. See *In re Keller*, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981).

Appellant provides no reasoning or support for the conclusion that the packet taught by Thompson would not be "sufficiently stiff or properly dimensioned" for holding metallic keys or key cards (Reply Brief, unnumbered page 16). See *In re Scarborough*, 500 F.2d 560, 566, 182 USPQ 298, 302 (CCPA 1974) (generally held that attorney argument is not sufficient to replace evidence or expert testimony). We note that the slot 42 disclosed by Thompson is exemplified as holding a baggage claim ticket (52) (see Figure 1), as well as being capable of holding travel tickets (col. 1, ll. 4-6). Claim 1 on appeal merely requires that the "one or more die-cuts" must be capable of serving "as a slot to hold a number of keys," and the type of key is not recited. Appellant has not set forth any reasoning

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why the slot 52 of Thompson would not be *capable* of holding a number of keys, whether the keys are metal or paper. See *In re Schreiber*, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997) (functional language does not confer patentability if prior art structure has capability of functioning in the same manner).

Appellant's argument that Thompson does not teach, mention or suggest a rectangular, single-sheet "entity of any kind" (Brief dated Mar. 11, 2004, page 12) is not well taken. The "rectangular" shape of the form has been discussed above. Thompson clearly discloses a "single-sheet" form (unitary blank 12; see Figure 2). Thompson also clearly discloses the corresponding number of score lines 30, 36 and 40 (instead of the claimed perforations), with a unitary blank where the packet (for holding baggage claim tickets or travel tickets) is *capable* of being folded into a complete packet in "two or fewer steps" as required by the claims on appeal (see col. 2, ll. 49-59).

For the foregoing reasons and those set forth in the Answer, we determine that the examiner has established a *prima facie* case of obviousness in view of the reference evidence to Thompson and Skelton.

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With regard to the rejection of claims 11-21, the examiner applies Thompson and Skelton as discussed above and in the Answer, and additionally applies Crowell to show the well known pre-printing of information by computer printers onto foldable sheets (Answer, page 7). From these findings, the examiner concludes that it would have been obvious to one of ordinary skill in the art at the time of appellant's invention to include pre-printing of information on the envelope of Thompson, as taught by Crowell, before folding (*id.*). We also agree with the examiner's findings of fact and conclusion of law.

Appellant admits that Crowell teaches imprinting on a card or sheet before assembly but argues that Crowell does not remedy the deficiencies in Thompson and Skelton (Brief dated Mar. 11, 2004, page 13). Accordingly, we adopt our remarks and reasons from above and determine that the examiner has established a *prima facie* case of obviousness in view of the reference evidence.

Appellant presents extensive arguments concerning secondary considerations of non-obviousness, i.e., commercial success, copying by others, attempts to remove patent pending labels, and long-felt need (Brief, pages 4-5; Brief dated Mar. 11, 2004, pages 4-9; and the Reply Brief, unnumbered pages 7-13).

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Accordingly, we re-evaluate the evidence for obviousness against appellant's countervailing evidence of non-obviousness. See *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).

Regarding the Wright Declaration under 37 CFR § 1.132 dated July 21, 2003, we find no evidence to support appellant's arguments but only Exhibits 1 through 4 showing the paper requirements for commercial printing. We determine that this evidence is not relevant to any argument of commercial success. Appellant apparently relies solely on the Wright Declaration under 37 CFR § 1.132 dated Nov. 27, 2002, with accompanying Exhibits A through D (Reply Brief, unnumbered pages 7-8). However, this evidence is not persuasive of unobviousness for the following reasons.

With regard to evidence of "commercial success," Declarant Wright states the sales figures for the years 2000, 2001 and the first five months of 2002 (Declaration, page 2). However, "information solely on numbers of units sold is insufficient to establish commercial success." *In re Baxter Travenol Labs.*, 952 F.2d 388, 392, 21 USPQ2d 1281, 1285 (Fed. Cir. 1991); see also *Cable Elec. Prods., Inc. v. Genmark, Inc.*, 770 F.2d 1015, 1026-27, 226 USPQ 881, 888 (Fed. Cir. 1985). Furthermore,

Declarant Wright states that "I feel that my [invention as claimed] currently enjoys about 99% of the current market." Declaration, page 2, underlining added. Declarant does not support this statement or "feeling" with any substantive economic evidence. See *Cable Elec. Prods.*, 770 F.2d at 1026, 226 USPQ at 888 ("Without further economic evidence, for example, it would be improper to infer that the reported sales represent a substantial share of any definable market"). For example, Exhibit A shows the order forms for two competing businesses (Focus Services and USFI) but Declarant has not specified, with concrete economic evidence, their share of the market or if other businesses have any market share (see the Reply Brief, unnumbered page 11).

Our reviewing court has also frequently held that

...for commercial success of a product embodying a claimed invention to have true relevance to the issue of nonobviousness, that success must be shown to have in some way been due to the nature of the claimed invention, as opposed to other economic and commercial factors unrelated to the technical quality of the patented subject matter. Thus, a 'nexus is required between the merits of the claimed invention and the evidence offered, if that evidence is to be given substantial weight enroute to [a] conclusion on the obviousness issue.' [Case citations omitted]. *Cable Elec. Prods., Inc. v. Genmark, Inc.*, 770 F.2d at 1026, 226 USPQ at 888.

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From our review of the evidence of record, we fail to find the required nexus between the merits of the claimed subject matter and the evidence offered.

With regard to Exhibit B, the e-mail correspondence merely states that the term "patent pending" on appellant's paper forms appears to be contrary to the Hilton company policy. Furthermore, there is no evidence that the e-mail sender was acting in any official capacity. Finally, Declarant has not shown that this alleged attempt to remove "patent pending" from appellant's paper forms constitutes evidence of nonobviousness.

With regard to Exhibit C, we note that this Exhibit merely shows prior art forms (Declaration, pages 3-4, ¶5). Finally, Exhibit D merely shows an embodiment of the claimed invention (Declaration, page 4).

Contrary to appellant's arguments, we find no substantive evidence in this Declaration of "copying" and "long-felt need" (Reply Brief, unnumbered page 7). Declarant's statement that "I believe that Hilton Hotels Corporation took this step" in order to bid out production of the claimed form to other printers (Declaration, page 3) is mere speculation and is unsupported by evidence. Furthermore, even assuming *arguendo* that Declarant's statement is correct, there is no substantive evidence of product

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copying. See *Cable Elec. Prods., Inc. v. Genmark, Inc.*, 770 F.2d at 1026-27, 226 USPQ at 888-889.

Based on the totality of the record, including due consideration of appellant's evidence and arguments, we determine that the preponderance of evidence weighs most heavily in favor of obviousness within the meaning of section 103(a). Therefore we affirm both rejections on appeal.

The decision of the examiner is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a)(1)(iv)(2004).

AFFIRMED

TERRY J. OWENS)	
Administrative Patent Judge)	
)	
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THOMAS A. WALTZ)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
)	
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TAW/TF

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